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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------|------------------|
| 10/809,298 | 03/25/2004 | Salvatore Sabbatino | 36040150 US-01 | 1499 |
| 7590 | 01/25/2006 | | | |
| Paul D. Greeley, Esq. Ohlandt, Greeley, Ruggiero & Perle, L.L.P. One Landmark Square, 10th Floor Stamford, CT 06901-2682 | | | EXAMINER KIANNI, KAVEH C | |
| | | | ART UNIT 2883 | PAPER NUMBER |

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/809,298 | Applicant(s) SABBATINO, SALVATORE | |
| | Examiner Kianni C. Kaveh | Art Unit 2883 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004 and 10 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 10-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 7-9 is/are rejected.
- 7) ☒ Claim(s) 3 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/29/04</u> | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to an arrangement that includes an optical subassembly , classified in class 385, subclass 92.
- II. Claims 10-24, drawn to subassembly, classified in class 174, subclass 256/262.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as transmission and or receiving of optical signals rather than electrical signals as claimed invention II. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Greeley on 1/10/06 a provisional election was made without traverse to prosecute the invention of I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

Figure 1 (see parag. 0030 of specification) should be designated by a legend such as --prior Art- because only that which is old is illustrated. See MPEP j 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

A proposed drawing correction or corrected drawings are required in reply to the office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC 112

Claims 2, 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation 'said electrical wires' in the 3rd line of claim. There is insufficient antecedent basis for this limitation in the claim. Correction is required.

Claim 4 recites the limitation 'said at least one absorber body' and 'said at least one further absorber body' in lines 25-26. There is insufficient antecedent basis for this limitation in the claim. Correction is required.

Claim 5 is ambiguous and indefinite, since the limitation 'electrical connection is a radio frequency' is not possible since radio wave is not an electrical connection rather as stated by the applicant in specification (parag. 0003) electrical signals of electrical subassembly may effect radio frequency. Correction is required.

Allowable Subject Matter

Claims 3 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 3 allowable because the prior art of record, taken alone or in combination, fails to disclose or render obvious a dielectric support board, wherein said electrical connection extends over said support board and said at least one electrical wire is arranged between said absorber body and said support board in combination with the rest of the limitations of the base claim.

Claims 6 allowable because the prior art of record, taken alone or in combination, fails to disclose or render obvious a further optical subassembly and a further electrical connection between said electrical subassembly and said further optical subassembly, said further electrical connection including at least one further electrical lead, the arrangement including at least one further electrically non-conductive electromagnetic absorber body arranged to at least partly cover said at least one further electrical lead in combination with the rest of the limitations of the base claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2883

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujieda et al. (US 2004/0146452).

Regarding claims 1, Fujieda teaches an arrangement (shown in at least fig. 11) including: an electrical subassembly (see at least 11), an optical subassembly (at least 13,5,9, 10; wherein item 10 is a laser diode emitting light) said electrical subassembly and said optical subassembly (at least 13,5,9, 10) having an associated electrical connection including at least one electrical wire extending therebetween (shown in at least fig. 11, item electrical wire extending from a laser driver circuit 11 to laser device 10, also wirings between optical elements such as between PD 19 and 20/18 and/or wirings between optical elements and main circuit board 14), and at least electrically non-conductive absorber body arranged to at least partly cover said at least one electrical wire (see at least abstract and parag. 0070).

However, Fujieda does not specifically state that the above electrical wire(s) is/are electrical lead(s). It is obvious/well-known to those of ordinary skill in the art when the invention was made that electrical wire(s) for electrical connection and/or transmitting/receiving radio signals are/known-as electrical leads since such electrical configuration would provide optical transmission or reception, automated tollgate, and high frequency communication equipment (see parag. 00002).

Regarding claims 2, 5, 7-9, Fujieda further teaches wherein said electrical connection includes a wire frame comprising a plurality of said electrical wires, said absorber body arranged to extend over said wire frame (see at least fig. 11, item 11 and/or 18 and/or 14 each consisting of electrical wires, see also abstract and see also figures 5 and 10 and parag. 0058); wherein said electrical connection is a radio frequency electrical connection between said electrical Subassembly and said optical subassembly (shown in at least fig. 12, item 27/28, also at least abstract); wherein said absorber body is selected out of the group consisting of magnetically loaded, iron loaded, ferrite loaded or dielectrically loaded materials (at least parag. 0016-0017) and/or comprised of a material selected from the group consisting of silicon, urethane, vinyl plastic and silicon rubber (see at least parag. 0007); wherein said absorber body is in the form of a sheet material (see at least figures 5-6 item absorption sheet 1).

Citation of Relevant Prior Art

Prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In accordance with MPEP 707.05 the following references are pertinent in rejection of this application since they provide substantially the same information disclosure as this patent does. These references are:

Johnson et al. 4204742 teaches at least claim 1

Fujieida et al. 2005/0140539 teaches at least claim 1

US 6919387 B2 Fujieda; Tadashi et al. teaches at least claim 1

Wichersheim et al. 5110216

US 20040234417 A1 Schienle, Meinrad et al.

US 3887882 A Smith

Tanaka et al. JP02003229632

These references are cited herein to show the relevance of the apparatus/methods taught within these references as prior art.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. Cyrus Kianni whose telephone number is (571) 272-2417.

The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 6:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font, can be reached at (571) 272-2415.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306 (for formal communications intended for entry)

or:

Hand delivered responses should be brought to Crystal Plaza 4, 2021 South Clark Place, Arlington, VA., Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-0956.

**KAVEH KIANNI
PRIMARY EXAMINER**


K. Cyrus Kianni
Primary Patent Examiner
Group Art Unit 2883

January 12, 2006